

21746



Patitioner's Docket No. U 013711-6

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: application of: Hiroyuki ONISHI, et al.

Application No.: 10/009,884

Group No.: 1746

Filed: November 13, 2001

Examiner: W.P. Fletcher, III

For: METHOD FOR SURFACE -TREATMENT, SURFACE-TREATED ARTICLE
AND DEVICE FOR SURFACE TREATMENT

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT
BEFORE MAILING DATE OF EITHER A FINAL ACTION
OR NOTICE OF ALLOWANCE (37 C.F.R. 1.97(c))

NOTE: 37 C.F.R. 1.97: "(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

(1) The statement specified in paragraph (e) of this section; or

(2) The fee set forth in § 1.17(p)."

NOTE: "If a final action or notice of allowance is mailed in an application and later withdrawn, the application will be considered as not having had a final action or notice of allowance mailed for purposes of considering an information disclosure statement." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

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Date: July 12, 2005

Signature

Clifford J. Mass
(type or print name of person certifying)

* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Transmittal of Information Disclosure Statement before Mailing Date of Either a Final Action Or Notice of Allowance—page 1 of 3) 64

Adjustment Date: 12/07/2005 SDIRETA1
07726/2005 BHARRIS1 00000002 120425 10009884
01 FC:1806 180.00 CR

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10009884
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120425
07726/2005
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180.00 CR

- [] Attached is a check in the amount of \$ _____.
[] Charge Account No. _____ in the amount of \$ _____.
A duplicate of this request is attached.

If any additional or lesser fees are due, please charge or refund deposit Account 12-0425.

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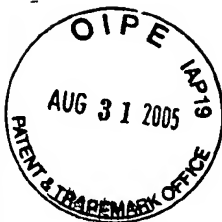
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SIGNATURE OF PRACTITIONER

Clifford J. Mass
(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023



Dep. & Ref.

2005 SEP -7

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hiroyuki ONISHI, et al

Serial No.: 10/009,884

Group No.: 1746

Filed: November 13, 2001

Examiner: W.P. Fletcher, III

For: METHOD FOR SURFACE - TREATMENT, SURFACE-TREATED ARTICLE
AND DEVICE FOR SURFACE TREATMENT

Attorney Docket No.: U 013711-6

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR REFUND

Deposit Account 12-0425 was charged \$180.00 for submission of Information

Disclosure Statement without Statement (Fee Code 1806) on July 26, 2005 (Control No. 2).

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*
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Date: August 29, 2005

Signature

CLIFFORD J. MASS

(type or print name of person certifying)

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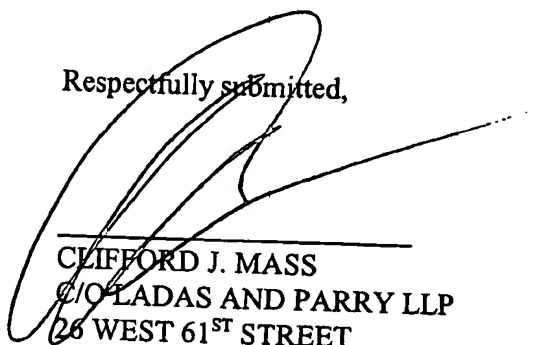
Each paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. 1.10(b).
"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will not be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

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Attached is the acknowledgment postcard stamped by the Patent Office
acknowledging receipt of the Statement. Also attached is a copy of the statement that was
mailed on July 12, 2005.

Therefore, we request a refund of the \$180.00, by credit, to Deposit Account 12-0425.

Respectfully submitted,



CLIFFORD J. MASS
C/O LADAS AND PARRY LLP
26 WEST 61ST STREET
NEW YORK, N Y 10023
REG. NO. 30,086 (212) 708-1890

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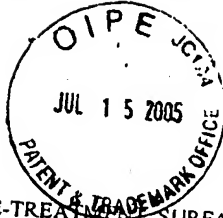
U 013711-6

IN RE: Hiroyuki ONISH, et al.

SERIAL NO.: 10/009.884

FILED: November 13, 2001

FOR: METHOD FOR SURFACE-TREATMENT, SURFACE-TREATED ARTICLE
AND DEVICE FOR SURFACE TREATMENT



July 12, 2005

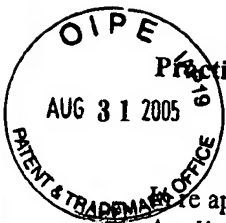
GROUP NO.: 1746

EXAMINER.: W.P. Fletcher, III

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT BEFORE MAILING DATE
OF EITHER A FINAL ACTION OR NOTICE OF ALLOWANCE (37 C.F.R. 1.97(b));
INFORMATION DISCLOSURE STATEMENT: STATEMENT FOR INFORMATION
DISCLOSURE STATEMENT UNDER 37 C.F.R. 1.97(c): FORM PTO-1449 AND REFERENCES

FILED _____

CJM/cy



Practitioner's Docket No. U 013711-6

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re application of: **Hiroyuki ONISHI, et al.**

Application No.: 10/009,884

Filed: November 13, 2001

For: **METHOD FOR SURFACE-TREATMENT, SURFACE-TREATED ARTICLE
AND DEVICE FOR SURFACE TREATMENT**

Group No.: 1746

Examiner: **W.P. Fletcher, III**

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

STATEMENT FOR INFORMATION DISCLOSURE UNDER 37 C.F.R. SECTION 1.97(e)

NOTE: A statement must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement." 37 C.F.R. Section 1.97(e).

Under the first statement under § 1.97(e), it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. See § 609B(5), M.P. E. P., 8th Edition.

CERTIFICATION UNDER 37 C.F.R. 1.8(a) and 1.10*

(When using Express Mail, the Express Mail label number is mandatory;
Express Mail certification is optional.)

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37 C.F.R. 1.8(a)

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TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office. to (703) 872-9306

37 C.F.R. 1.10*

as "Express Mail Post Office to Addressee"
Mailing Label No. _____ (mandatory)

Date: July 12, 2005

Signature

Clifford J. Mass

(type or print name of person certifying)

* Only the date filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continue to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

NOTE: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19. See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. 1.10." See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

See § 609B(5), M.P.E.P., 8th Edition:

"If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement."

NOTE: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the certification has a duty to make reasonable inquiry regarding the facts that are being certified. The certification can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a certification under 37 C.F.R. 1.97(e)(2) to the Office until a satisfactory response is received. The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee" in a certification procedure under Section 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

NOTE: The mere absence of an item of information for a foreign patent office communication is not intended to represent an opportunity to delay the submission of a item known more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under Section 1.56. 62 Fed. Reg. 53,131, 53,150 (Oct. 10, 1997).

NOTE: The IDS is considered filed as of the date it is received in the PTO, or on an earlier date.

transmission if done so with a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. § 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. § 1.10. See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The certification under Section 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.

NOTE: "The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. Section 1.56(d) and

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. Section 1.56(c).

IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT FOR WHICH THIS STATEMENT IS BEING MADE

1. This statement is being made for the Information Disclosure Statement
☒ accompanying this statement.
☐ filed _____
Date

STATEMENT

2. I, the person(s) signing below state:

that each item of information contained in the information disclosure statement was **first** cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(1).

NOTE: The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

OR

that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, was known to any individual designated in Section 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. Section 1.97(e)(2).

NOTE: "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT

3. The person making this statement is

(check each applicable item)

(a) ☐ the inventor(s) who signs below

SIGNATURE OF INVENTOR

(type name of inventor who is signing)

(b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. Section 1.56(c)) and who signs below.

SIGNATURE OF PERSON MAKING STATEMENT

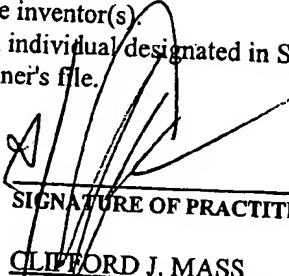
(type name of person who is signing)

Address of person who is signing

(c) ☒ the practitioner who signs below on the basis of the information:

(check each applicable item)

- ☐ supplied by the inventor(s).
☒ supplied by an individual designated in Section 1.56(c).
☒ in the practitioner's file.



SIGNATURE OF PRACTITIONER

CLIFFORD J. MASS
(type or print name of practitioner)

P.O. Address

c/o Ladas & Parry LLP
26 West 61st Street
New York, N.Y. 10023

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